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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/429,723	10/29/1999	CLAUDE HOPE	BAL6019P0011	6250

7590 09/03/2004

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EXAMINER

GRUNBERG, ANNE MARIE

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/429,723

**Applicant(s)**

HOPE ET AL.

**Examiner**

Anne Marie Grunberg

**Art Unit**

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 41-65,73 and 74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-65,73 and 74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/17/04 has been entered.

Claims 41-65 and 73-74 are pending. Claims 1-40, 66-72 and 75-76 are canceled.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Drawings***

Color photographs and color drawings are acceptable only for examination purposes unless a petition filed under 37 CFR 1.84(a)(2) is granted permitting their use as acceptable drawings. In the event that applicant wishes to use the drawings currently on file as acceptable drawings, a petition must be filed for acceptance of the color photographs or color drawings as acceptable drawings. Any such petition must be accompanied by the appropriate fee set forth in 37 CFR 1.17(h), three sets of color drawings or color photographs, as appropriate, and, unless already present, an

Art Unit: 1661

amendment to include the following language as the first paragraph of the brief

description of the drawings section of the specification:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings have been satisfied.

### ***Claim Rejections***

1. Claims 41-44, 46-52, 54-62, 64-65 and 73-74 are rejected under 35 U.S.C.

102(b) as being anticipated by Harbaugh et al.

Claims 41-44, 46-52, 54-62, 64-65 and 73-74 are drawn to a Eustoma plant or its parts, having reduced apical dominance or a method of breeding such a plant.

Harbaugh et al teach Eustoma having a recessive allele for reduced apical dominance (page 1057, column 2, for example). Seed is taught at page 1058 at the bottom of the second column. Pollen and ovules are inherent parts of plants and thus, are also taught by Harbaugh et al. An eustoma cutting is taught at page 1058, column 1, for example. Methods of producing a hybrid plant are well known in the art and are taught at page 1057, column 2, for example. Hybrid eustoma plants and inherently seed are discussed also at page 1057, column 2.

Applicant argues that Harbaugh et al do not disclose or suggest seed of inbred line 752 or hybrid plant 3087, plants or plant parts regenerated from this seed, or the use of these plants in breeding.

Applicant's arguments filed 06/17/04 have been fully considered but they are not persuasive because the claims are not drawn to a particular genotype characterized in the specification by enough traits other than that caused by the reduced apical dominance. Furthermore, since the reduced apical dominance trait already existed and has been described in Eustoma, the claimed invention can not be distinguished from the prior art.

2. Claims 41-65 and 73-74 are rejected under 35 U.S.C. 102(b) as being anticipated by Griesbach et al.

Griesbach et al teach Eustoma having a recessive allele for reduced apical dominance (page 790, column 3, for example). At page 790, column 2, first sentence under "*Causes of variability*" several variant plants produced by tissue culturing were basally branched, thus indicating reduced apical dominance. Tissue culture was used to induce somaclonal variation (page 790, column 2, lines 14-17). Seed is taught at page 790, second paragraph, for example. Pollen and ovules are inherent parts of plants and thus, are also taught by Griesbach et al. An eustoma cutting is taught at page 790, column 2, first full paragraph for example. Methods of producing a hybrid plant are well known in the art and are taught at page 790, at the bottom of column 1 and top of column 2, for example. Griesbach et al also teach a method for producing FI hybrid Eustoma seed wherein the first and second parent plant exhibit reduced apical dominance (page 790, column 3, lines 15-17). Hybrid eustoma plants and inherently

Art Unit: 1661

seed are discussed also at page 790, column 2. The selfed progeny described in Griesbach et al were raised, indicating that the seed was germinated and grown into a plant.

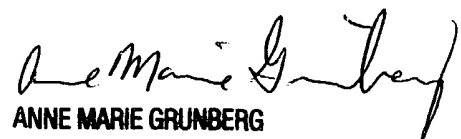
Although the claims are drawn to deposited lines, the specification does not characterize the claimed *Eustoma* lines other than in the recessive allele for reduced apical dominance. As a result, any *Eustoma* plants that have increased basal branching read on the deposited plants.

No claim is allowed.

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie Grünberg whose telephone number is (571) 272-0975. The examiner can normally be reached from Monday through Thursday from 7:30 until 5:00, and every other Friday from 7:30 until 4:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached at (571) 272-0811. The fax number for the unit is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

  
ANNE MARIE GRÜNBERG  
PRIMARY EXAMINER